

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIDEKI HIRATA,
HAJIME UTSUNOMIYA, ISAMU KURIBAYASHI,
and HIROSHI TANABE

Appeal No. 1998-1470
Application 08/533,740¹

ON BRIEF

Before BARRETT, RUGGIERO, and BARRY, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed September 26, 1995, entitled (as amended) "Optical Device With Protective Cover."

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-4, 6-9, and 11. Claim 10 is said to be redundant to claim 7 and, while not canceled, is not appealed.

We affirm-in-part.

BACKGROUND

The invention is directed to an optical disc assembly having a glass substrate that is designed to prevent a failure of the glass substrate near its corner upon receipt of physical shocks.

Claim 1 is reproduced below.

1. An optical disc, comprising:

a disc-shaped glass substrate defining a pair of major surfaces and an outer side and having information-carrying means on one major surface,

a resin protective member including a disc-shaped covering portion and an annular rim extending from the periphery of the covering portion,

an adhesive layer integrally joining said substrate and said protective member,

the information-carrying means of said glass substrate faces the covering portion of said protective member and the outer side of said glass substrate is surrounded by the annular rim to leave a space between the outer side of said glass substrate and an inner surface of the annular rim.

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The Examiner relies on the following prior art:

Hoogeveen et al. (Hoogeveen)	4,622,661	November
11, 1986		

Claims 1-4, 6-9, and 11 stand rejected under 35 U.S.C.
§ 103 as being unpatentable over Hoogeveen.

We refer to the Final Rejection (Paper No. 6) and the Examiner's Answer (Paper No. 13) (pages referred to as "EA__") for a statement of the Examiner's position and to the Appeal Brief (Paper No. 12) (pages referred to as "Br__") for a statement of Appellants' arguments thereagainst.

OPINION

Although Appellants identify claims 1-4 and 6 as one group of claims and claims 7-9 and 11 as a second group of claims (Br5), Appellants argue independent claims 1 and 7 as one group and dependent claims 6 and 11 as a second group. Accordingly, we consider claims 1-4 and 7-9 to stand or fall together, with claim 1 considered as representative, and claims 7 and 9 to be a second group, with claim 6 considered as representative.

Claims 1-4 and 7-9

Appellants argue that the essential difference between Hoogeveen and the subject matter of claims 1 and 7 is the claimed recitation of "an adhesive layer integrally joining said substrate and said protective member." Appellants argue that Hoogeveen discloses that brim 44 is secured to substrate 41 "by means of an adhesive" (col. 4, line 25), but does not define any purpose of the adhesive and thus fails to teach the advantages of an adhesive layer which not only adheres the protective rim to the substrate, but also provides the structure and function of damping the shocks conducted to the glass substrate (Br5-6).

The Examiner responds that the claims do not define any additional purpose for the adhesive, so Appellants' argument is not commensurate in scope with the claims (EA8). The Examiner further opines that even if the alternate purpose of providing damping was claimed, the adhesive in Hoogeveen would fulfill the same role (EA8).

We agree with the Examiner that the claims do not recite any purpose for the adhesive other than "integrally joining said substrate and said protective member," which is accomplished by Hoogeveen. Although most adhesives are not

totally rigid and, therefore, would perform some amount of shock damping, it is not necessary to consider whether Hooegeveen would have satisfied the function of damping shocks if the function had been recited. We conclude that the Examiner has established a prima facie case of obviousness. The rejection of claims 1-4 and 7-9 is sustained.

Claims 6 and 11

The Examiner stated (Paper No. 4, pages 5-6; FR4):

Hooegeveen et al does not show the space being filled with a resin. However, filling spaces in optical disks with resin is old and well known throughout the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the disc of Hooegeveen et al with the space between the outside of the substrate and the inside of the rim being filled with a resin. One of ordinary skill in the art would have been motivated to provide a more durable and stable disc while utilizing a known lightweight optical disc material.

Appellant argues even assuming the Examiner's contention that filling spaces in optical disks with resin was well known is correct, "there is no teaching in the reference for filling the space between the protective member rim and the outer surface of the glass substrate as claimed by the applicants' [sic]" (Br7).

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The Examiner responds that Appellants did not seasonably challenge the Examiner's finding of Official Notice that "filling spaces in optical disks with resin is old and well known throughout the art" and, therefore, according to the Manual of Patent Examining Procedure § 2144.03, the finding is taken to be admitted prior art (EA9).

We do not consider that filling spaces in optical disks with resin is the kind of fact that is proper for Official Notice; it is not a fact of which we are aware, nor do we think the Federal Circuit, which is responsible for reviewing our decisions, is likely to have knowledge about this finding. Nevertheless, we agree with the Examiner that findings of Official Notice must be seasonably challenged. Here, however, Appellant argues that even if the finding is correct, it does not address filling the space between the protective member rim and the outer surface of the glass substrate, as claimed. We agree with Appellant. The Official Notice is not commensurate in scope with the claim limitation. There must be some motivation for filling the space between the rim and glass substrate. Hoogeveen expressly discloses that there should be a space at the outer circumference of the substrate

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in which no intermediate means are present which can transmit a force toward the disc (col. 4, lines 59-68). Thus, Hoogveen discourages filling the space with material. For this reason, we conclude that the Examiner has failed to establish a prima facie case of obviousness. The rejection of claims 6 and 11 is reversed.

CONCLUSION

The rejection of claims 1-4 and 7-9 is sustained.

The rejection of claims 6 and 11 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

LEE E. BARRETT)	
Administrative	Patent Judge)
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES

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LANCE LEONARD BARRY)
Administrative Patent Judge)

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R.J. Lasker, Esq.
LAUBSCHER & LAUBSCHER
Suite 300
745 23rd Street
Arlington, VA 22202